



PATENT

16/Decl.
P. Walker
11-1508

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Spencer A. Rathus et al.

Serial No.: 09/365,961

Group Art Unit: 2876

Filed: August 2, 1999

Examiner: Thien Minh Le

For: METHOD AND APPARATUS FOR
ACCESSING ELECTRONIC DATA
VIA A FAMILIAR PRINTED MEDIUM

Atty. Doc. No.: 660-013

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

DECLARATION UNDER 37 CFR § 1.131

I am one of the inventors named on the U.S. patent application identified above. I have read and am familiar with the contents of the above-referenced application including claims 168-245. I have also read and am familiar with the contents of the Office Action mailed on April 24, 2002. I also understand that the Examiner has rejected claims 168-170, 174, 184-185, 199-200, 202-204, 206-207, 216-217, and 232-234 under 35 U.S.C. § 102(e) as being anticipated by Swartz et al. U.S. Patent No. 6,095,418 (hereinafter referred to as "Swartz") or under 35 U.S.C. § 102(e) in view of Kunihiro Japanese Patent No. 407108786A (hereinafter referred to as "Kunihiro").

Additionally, the Examiner rejected claims 171-173, 175-183, 186-198, 201, 205, 208-215, 218-231, and 235-245 under 35 U.S.C. § 103(a) as being unpatentable over Swartz and/or Kunihiro in view of the general teachings of the cited prior arts. I, therefore, submit this declaration to demonstrate, as per the requirements of 37 C.F.R. § 1.131(b), conception of the invention defined by claims 168-245 prior to the filing date of the earliest of the two references cited by the Examiner as well as due diligence from a time prior to the earliest reference date through the filing of the original application (i.e., constructive reduction to practice).

Specifically, the invention defined by claims 168-245 was conceived prior to October 15, 1993, the filing date of the Kunihiro reference, and prior to January 27, 1994, the filing date of the Swartz reference. A true copy of a portion of my notes created prior to October 15, 1993 is appended hereto and entitled "Exhibit A". The date written on the bottom right hand corner of Exhibit A has been blocked out and is a date prior to October 15, 1993.

Generally, Exhibit A depicts all elements of the invention as defined by claims 168-245. Specifically, Exhibit A provides evidence of conception of all elements of the two independent

claims 168 and 199 including programming material, printed matter, a sensor, a controller, a transmitter, a receiver, a display unit, a recognizable feature, and a feature recognition unit.

Appendix A illustrates printed matter, which is entitled "SmartBook". The SmartBook is described in parenthesis as a "book, magazine, manual, sheet music, catalog, etc. that contains BookMarks". The term "BookMarks" corresponds to either the claimed sensor or machine recognizable feature, depending on the application. A BookMark, as described in Appendix A, "may be microscopically hard-wired to the microprocessor in the Smartbook, or communicate with it via electromagnetic waves". Appendix A further illustrates in the Overview that the BookMark may be touched or scanned by the reader. If the BookMark senses touch, it acts as a sensor as claimed in claims 168-198. If the reader scans the BookMark, the Bookmark acts as a machine recognizable feature as claimed in claims 199-245. In the embodiment where the BookMark is scanned, Appendix A specifically states that a "scanner" sends a signal to the microprocessor in the SmartBook. The scanner is one form of a feature recognition unit, as claimed in claims 199-245.

Programming material is also illustrated in Appendix A.

Appendix A states that the "microprocessor may instruct a computer to load and run a multimedia presentation or program from a CD-ROM, diskette, PCMCIA card, etc., or else that microprocessor may instruct a personal computer to retrieve and run a multimedia presentation or program from a centralized data bank." Multimedia presentations provided by media such as CD-ROM, diskette, PCMCIA cards, etc. are forms of programming material as defined in the specification and claims of the above-referenced application.

In addition, Appendix A illustrates a first controller, transmitter, second controller, and receiver as claimed in claims 168-198 as well as an intelligent controller, transmitter, and receiver as claimed in claims 199-245. As claimed in claims 168-198, the microprocessor functions as a first controller. The microprocessor responds to actuation of the BookMark, or sensor, by transmitting a signal via an electromagnetic wave to a second controller, or centralized data bank. The centralized data bank receives the signal sent from the microprocessor and acts to display or execute programming material in response to the signal received from the microprocessor.

Alternatively, also as detailed in Appendix A, a scanner

containing a transmitter is utilized to transmit a signal to a microprocessor, which acts as an intelligent controller. The microprocessor has a receiver that acts to receive the signal. In response, the microprocessor causes programming material to be displayed, for example, by displaying a multimedia presentation on a SmartPage contained within the SmartBook.

Finally, Appendix A illustrates multiple embodiments of a display unit. At the top, left corner of Appendix A, a display unit is shown and is entitled "TV Set, Personal Computer, or SmartPage." The Overview contained in Appendix A states that "the indicated multimedia presentation or program to be retrieved from a centralized data bank and played on a TV set, personal computer, or on the SmartPage." Therefore, Appendix A illustrates the use of a display unit for display of the programming material.

Exhibit A contains a complete technical description of the apparatus and method defined by claims 168-245. I prepared Exhibit A in the United States prior to October 15, 1993. Therefore, Exhibit A is evidence that the invention defined by claims 168-245 was conceived prior to the October 15, 1993 filing date of the Kunihiro reference and prior to the January 27, 1994 filing date of the Swartz reference.

Additionally, Jeffrey S. Nevid, Lois Fichner-Rathus, and I proceeded with due diligence from a time prior to the date of the earliest reference cited by the Examiner to the date of filing of the original application (i.e., constructive reduction to practice). Specifically, Jeffrey S. Nevid, Lois Fichner-Rathus, and I proceeded with due diligence from a time prior to the October 15, 1993 filing date of the Kunihiro reference to the filing date of our original application, Application Serial No. 08/250,799 (hereinafter referred to as "the '799 Application").

I do not know and do not believe that the invention, as defined in claims 168-245, has been in public use or on sale in this country or patented or described in a printed publication in this country or any foreign countries for more than one year prior to our application and I have never abandoned, suppressed, or concealed the invention.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: October 15, 2002 By: Spencer A. Rathus
October 15, 2002 Dr. Spencer A. Rathus